

REMARKS

Claims 1-22 are pending in this application.

Claims 1-22 are rejected.

Claims 1, 3, 5, 12, 14, and 16 have been amended as shown above.

Reconsideration of the claims is respectfully requested.

CLAIM REJECTION UNDER 35 U.S.C. § 103

Claims 1, 3-12, and 14-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0057657 to *La Porta et al.* ("La Porta") in view of U.S. Patent Publication No. 2002/0193139 to *Mildh et al.* ("Mildh") and U.S. Patent Publication No. 2004/0005884 to *Nieminen et al.* ("Nieminen") and further in view of U.S. Patent No. 6,233,452 to *Nishino* ("Nishino"), U.S. Patent No. 6,580,699 to *Manning et al.* ("Manning"), and U.S. Patent No. 7,110,377 to *Hsu et al.* ("Hsu"). Claims 2 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over La Porta in view of Mildh, Nieminen, Nishino, Manning, and Hsu, and further in view of U.S. Patent No. 6,999,766 to *Padovani* ("Padovani"). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142, p. 2100-127 (8th ed. rev. 7 July 2008). Absent such a *prima facie* case, the applicant is under no obligation to produce evidence of nonobviousness. *Id.*

To establish a prima facie case of obviousness, three basic criteria must be met: First, there must be some reason – such as a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art – to modify the reference or to combine reference teachings. MPEP § 2142, pp. 2100-127 to 2100-128 (8th ed. rev. 7 July 2008); MPEP § 2143, pp. 2100-128 to 2100-139; MPEP § 2143.01, pp. 2100-139 to 2100-141. Second, there must be a reasonable expectation of success. MPEP § 2143.02, pp. 2100-141 to 2100-142 (8th ed. rev. 7 July 2008). Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. MPEP § 2143.02, pp. 2100-141 to 2100-142 (8th ed. rev. 7 July 2008).

Independent Claim 1 has been amended to recite a mobile switching center capable of sending an assignment request wherein the assignment request comprises an IP address of the second base station. Support for this feature can be found throughout the Applicants' disclosure (e.g., paragraph [045]). This feature is not taught or suggested by La Porta, Mildh, Nieminen, Nishino, Manning, or Hsu, separately or in combination. The Office Action relies on Manning to teach an assignment request. However, Manning does not teach anything about an assignment request that includes an IP address of a destination base station. The other references also fail to teach or suggest this feature.

Independent Claim 1 also recites that the first base station is capable of receiving a first message directly from said source mobile station indicating that said source mobile station is to be handed off to a third base station. This feature is not taught or suggested by La Porta, Mildh, Nieminen, Nishino, Manning, or Hsu, separately or in combination. The Office Action suggests that

the handoff path setup message in La Porta teaches the first message. However, the handoff path setup message in La Porta is sent from the mobile station to the new base station. Thus, the handoff path setup message is not sent directly to the old base station. Thus, La Porta fails to teach or suggest that the first base station is capable of receiving a first message directly from said source mobile station. The other references also fail to teach or suggest this feature.

Therefore, Claim 1 is patentable over La Porta, Mildh, Nieminen, Nishino, Manning, Hsu, and any combination of these references. Independent Claim 12 recites features analogous to those of Claim 1 discussed above. Accordingly, Claim 12 is also patentable over La Porta, Mildh, Nieminen, Nishino, Manning, Hsu, and any combination of these references. Claims 2-11 depend from Claim 1. Claims 13-22 depend from Claim 12. These claims are patentable at a minimum due to their dependence from allowable base claims.

The dependent claims are also patentable in light of their own recitations. For example, Claims 3, 5, 14, and 16 recite a message that contains a service option field indicating a MS-MS packet data call. This feature is not taught or suggested by La Porta, Mildh, Nieminen, Nishino, Manning, or Hsu, separately or in combination. The Office Action asserts that the message type in La Porta teaches the service option field. However, the message type in La Porta is used to distinguish between the three types of path setup messages—power up, handoff, and refresh. The message type in La Porta is not used to indicate that a call is a MS-MS packet data call.

Furthermore, Claims 5 and 16 recite that the mobile switching center responds to a second message by transmitting a third message to a third base station. The Office Action asserts that such a feature is obvious given the setup messages taught in La Porta. However, La Porta does not disclose

any type of setup message at all that is sent from a mobile switching center to a base station. Thus, the recited feature could not reasonably be considered obvious.

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection.

CONCLUSION

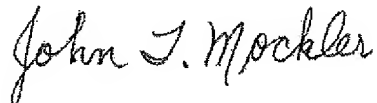
As a result of the foregoing, the Applicant asserts that the remaining claims in the Application are in condition for allowance, and respectfully requests that this Application be passed to issue.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *jmockler@munckcarter.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

MUNCK CARTER, LLP



John T. Mockler
Registration No. 39,775

Date: 22 March 2010
P.O. Drawer 800889
Dallas, Texas 75380
Phone: (972) 628-3600
Fax: (972) 628-3616
E-mail: *jmockler@munckcarter.com*